



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,815	06/26/2003	Francois Cottard	239098US0	2794
22850 7590 01/09/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER ELHILO, EISA B	
			ART UNIT	PAPER NUMBER
			1751	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/603,815	Applicant(s) COTTARD ET AL.	
	Examiner Eisa B. Elhilo	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1751

DETAILED ACTION

1 This action is responsive to the amendment filed on December 21, 2006.

2 A request for continued examination under 37 CFR 1.114, including the fee set forth in
37 CFR 1.17(e), was filed in this application after final rejection. Since this application is
eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)
has been timely paid, the finality of the previous Office action has been withdrawn pursuant to
37 CFR 1.114. Applicant's submission filed on 12/21/2006 has been entered.

Claim Rejections - 35 USC § 103

3 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-23 and 25-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Casperson et al. (US 5,376,146) in view of Duffer et al. (US 2003/0028979 A1).

Casperson et al. (US' 146) teaches a composition comprising oxidation dyes (see col. 5, line 33), alkalizing agent of sodium silicate and alkanolamine of ethanolamine as claimed in claims 1-4 (see col. 5, lines 12-29), wherein the alkanolamine presents in the amount of 0.1 to 5% as claimed in claims 5-10 (see col. 5, line 31 and col. 11, Examples 1-40 composition No. 5), wherein the pH of the composition is in the ranges of 7 to 11 as claimed in claims 11-12 (see col. 5, line 10), wherein the oxidation dye is selected from oxidation bases of paraphenylenediamines as claimed in claims 13-15 (see col. 5, lines 40-41) and couplers of 1,3-phenylenediamines (meta-phenylenediamines) as claimed in claims 16 and 20 (see col. 7, lines 28-29), wherein the

Art Unit: 1751

oxidation bases and couplers are employed in the amounts of .0005% to about 5% which are fall within the claimed ranges as claimed in claims 19 and 21 (see col. 8, lines 30-34), wherein the addition acid salts are sulfates and hydrochlorides as claimed in claims 17-18 (see col. 6, lines 25-26), wherein the composition comprises organic solvents as claimed in claim 22 (see col. 9, line 25), wherein the organic solvents in the amounts of 0% to 5% which is overlapped with the claimed range as claimed in claim 23 (see col. 9, line 25), wherein the composition further comprises hydrogen peroxide as claimed in claims 25-26 (see col. 9, lines 52-53).

Casperson et al. (US' 146) also teaches a method for dyeing hair comprising applying to the hair the dyeing composition as described above and wherein the composition is remained for a period of time after which the composition is washed from the hair as claimed in claims 27-30 (see col. 10, lines 50-66).

The instant claims differ from the reference by reciting a composition comprising alkalinizing agent of metasilicates.

Duffer et al. (US' 979 A1) in analogous art of hair dyeing formulation, teaches a composition comprising alkalizing agents of sodium metasilicate and sodium silicate (see page 3, paragraph, 0039).

Therefore, in view of teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would be motivated to modify the composition of Casperson et al. (US' 146) by replacing the alkalizing silicate with the alkalizing metasilicate as taught by Duffer et (US' 979 A1) to arrive at the claimed invention. Such a modification would be obvious because Casperson as a primary reference suggests the use of alkalizing agent of silicate in the composition. Duffer et al. as a secondary reference clearly teaches the equivalence

Art Unit: 1751

of alkalizing agents of silicates and metasilicates and their mixture in the composition, and, thus, the person of ordinary skill in the art would be motivated to replace the silicates in the composition of Casperson with the metasilicates as taught by Duffer with reasonable expectation of success to arrive at the claimed invention and would expect such composition to have similar properties as those claimed, absent unexpected results.

With respect to claims 31-33, it would have been obvious to one having ordinary skill in the art at the time the invention was made to formulate a composition comprising metasilicates and alkanolamines in the claimed ration, because Duffer et al. (US' 979 A1) clearly teaches a mixture of alkalizing agents that include metasilicates and alkanolamine in the amounts of 1-5% which within the claimed amounts for imparting alkalinity (see page 3, paragraph, 0039), and, thus, a person of the ordinary skill in the art would be motivated to optimize the ratio between these alkalizing agents with a reasonable expectation of success for imparting alkalinity of the composition, and would expect such a composition to have similar properties to those claimed, absent unexpected results.

4 Claims 1, 3-4, 11, 13-16, 19-22 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dias et al. (US 6,004,355) in view of Duffer et al. (US 2003/0028979 A1).

Dias et al. (US' 355) teaches a hair dyeing composition comprising oxidation dyes of para-phenylenediamines in the amount of 0.24% which is within the claimed range as claimed in claims 1, 13-15 and 19 (see col. 32, Example I), buffering (alkalizing) agent of monoethanolamine as claimed in claims 3-4 (see col.22, line 27), magnesium silicate (see col. 31, lines 3-4), couplers of m-aminophenols in the amount of 0.06% which within the claimed range as claimed in claims 16, 20-21 (see col. 32, Example I), organic solvents as claimed in

Art Unit: 1751

claim 22 (see col. 25, lines 10-21), cationic polymers in the amount of 0.05 to 2% and nonionic surfactants in the amount of 1.5 wherein the amounts of the polymers and nonionic surfactants are within the claimed ranges as claimed in claim 24 (see col.30, lines 55-56, col. 31, line 22 and col. 32, Example I), wherein the composition also comprises oxidizing agent of hydrogen peroxide as claimed in claims 25-26 (see col. 22, lines 56-58), wherein the composition has a pH in the range of 7 to 10.5 which is within the claimed range as claimed in claim 11 (see col. 21, line 67).

The instant claims differ from the reference by reciting a composition comprising alkalinizing agent of metasilicates.

Duffer et al. (US' 979 A1) in analogous art of hair dyeing formulation, teaches a composition comprising alkalizing agents of sodium metasilicate and sodium silicate (see page 3, paragraph, 0039).

Therefore, in view of teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would be motivated to modify the composition of Dias et al. (US' 335) by replacing the alkalizing silicate with the alkalizing metasilicate as taught by Duffer et (US' 979 A1) to arrive at the claimed invention. Such a modification would be obvious because Dias et al. as a primary reference suggests the use of alkalizing agent of silicate in the composition. Duffer et al. as a secondary reference clearly teaches the equivalence of alkalizing agents of silicates and metasilicates and their mixture in the composition, and, thus, the person of ordinary skill in the art would be motivated to replace the silicates in the composition of Dias et al. with the metasilicates as taught by Duffer with reasonable expectation of success to arrive at

Art Unit: 1751

the claimed invention and would expect such composition to have similar properties as those claimed, absent unexpected results.

Response to Applicant's Arguments

5 With respect to the rejection of claims 1-23 and 25-33 under 35 U.S.C. 103(a) as being unpatentable over Casperson et al. (US' 146) in view of Duffer et al. (US' 979 A1), applicant argues that Casperson does not teach or suggest that alkanolamines and organic or inorganic alkalizing agents can be used together or any benefits resulting from such a combination. Applicant also argues that Casperson neither teaches nor suggests the selection of at least one metasilicate and at least one alkanolamine as claimed.

The examiner respectfully disagrees with the above arguments because Casperson et al. (US' 146) teaches that any compatible ammonia derivatives can be used as alkalizing agents and any other organic or inorganic alkalizing agents may also be used such as sodium silicate (see col. 5, lines 15-27). Further, Casperson clearly teaches that the preferred alkaline reagents are ammonium hydroxide, sodium carbonate and ethanolamine (see col. 5, lines 27-28). Therefore, there is a clear suggestion and sufficient motivation to one having ordinary skill in the art to be motivated to select any alkalizing agent including the claimed species to formulate such a composition to arrive at the claimed invention.

Further, with respect to the argument that Casperson neither teaches nor suggests the selection of at least one metasilicate and at least one alkanolamine as claimed, and in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

Art Unit: 1751

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant further argues that the combination of Casperson and Duffer would not lead one skilled in the art to use both a metasilicate and an alkanolamine as is required by the present invention. The examiner respectfully disagrees with the above argument because Casperson et al. as a primary reference clearly teaches a dyeing composition comprising alkalizing agents such as alkylamines and sodium silicates (see col. 5, lines 15-28). Duffer et al. as a secondary reference clearly teaches that that dyeing composition contains one or more alkalizing agents such as alkanolamines, sodium silicate and sodium metasilicate of the claimed species (see page 3, paragraph, 0039), and thus, Duffer et al. teaches the equivalence of alkalizing agents of silicates and metasilicates that can be used together with alkanolamines. Therefore, there is a sufficient motivation to one having ordinary skill in the art to be motivated to replace the silicates in the composition of Casperson with the metasilicates as taught by Duffer to arrive at the claimed invention with the reasonable expectation of success for imparting alkalinity of the dyeing composition, absent unexpected results.

Furthermore, applicant argues that Dias et al. states that magnesium silicate can optionally be added to his compositions and does not teach or suggest that such a compound could be an alkalizing agent.

The examiner respectfully disagrees with the above argument because a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed.Cir.), *cert. denied*, 493 U.S. 975 (1989). In this case Dias et al. suggests the

Art Unit: 1751

use of silicate component in the dyeing composition, and thus, a person of the ordinary skill in the art would acknowledge that the dyeing composition may comprise silicate component no matter if the silicate component is used separately or with the combination of alkanolamine in the dyeing composition and would expect such a composition to have similar property to those claimed in the absence of contrary.

With respect to the applicant's arguments based on the improved beneficial properties associated with the claimed compositions such as good dyeing properties, improved sensory characteristics and homogeneous coloring, The examiner advises applicant to provide a comparative data or showing to demonstrate that the claimed composition has a superior and unexpected results over the composition of the closest prior art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B. Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

Art Unit: 1751

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Eisa Elhilo".

Eisa Elhilo
Primary Examiner
Art Unit 1751

January 5, 2007